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#19/RESPONSE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

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| Yoshihiko Shioda | ) | |
| Serial No.: 09/444,120 | ) | Examiner: RaeAnn Gorden |
| Filed: November 19, 1999 | ) | |
| For: GOLF PRACTICE AND EXERCISE DEVICE | ) | Art Unit: 3711 |



Charlotte, North Carolina March 12, 2003

BOX RESPONSE NO FEE
Commissioner for Patents
Washington, DC 20231

**RESPONSE**

This is in response to the Official Action of December 18, 2002, reopening the above-identified application, which was on appeal, and rejecting the claims on new grounds.

It is noted that in reopening the prosecution of this application the basis for the final rejection is no longer being asserted. Obviously, the Examiner has determined that there was no merit to the rejection stated in the final Office Action, yet the arguments presented in the Appeal Brief were no different from the arguments presented for allowance preceding the final Office Action. Had the Examiner recognized the merit of applicant's arguments when first presented before the final Office Action, there would have been no need to appeal this application. Applicant has expressed to his undersigned attorney his consternation in having to have incurred the substantial legal fees and delay of appealing this application when the arguments on appeal are the same as the arguments presented prior to the final Office Action.

Applicant's concern is exacerbated by the Examiner now rejecting the claims of the application on a single prior art patent that is cited for the first time after three years of pendency of the application. This prior art patent was available during the Examiner's previous searches.

The clear assumption is that when the Examiner reviewed this patent previously he considered it of no relevance while citing other patents. Having not considered this patent relevant for three years and now using it as a basis for reopening prosecution of this application is an unreasonable imposition on applicant and constitutes piece meal examination, which is to be discouraged according to MPEP § 707.07(g).

There is reason why the Davis '312 patent would not have been cited earlier and that reason applies now as well as it did at any time during the three year pendency of the present application. The title alone, Automatic Ball Retrieving Device, indicates that it is not relevant. The claims pending in the present application have nothing to do with retrieving of an object.

A review of the details of the disclosure of the Davis '312 patent is further evidence of the lack of relevance. In column 2, lines 4-9, it is stated:

> The ball retrieving device is safe to utilize since the ball is not retrieved by the device until the practicing player desires to retrieve it. At this time, the ball is slowly and gently returned to its place of origin so that there is no danger of injury to the practicing player if he should fail to move out of its path.

In column 2, lines 34-40, it is stated:

> An additional object of the present invention is to provide an automatic ball retrieving device which permits a ball of the type used in various sports to be struck by the types of instrument used in the sports and propelled through a considerable distance without the development of excessive slack in the line which is utilized to retrieve the ball.

In column 4, lines 50-59, it is stated:

> After the ball 14 is struck by the bat, club, or racket of the practicing player, it is propelled away from the housing 10 so that the line 12 is unreeled from the drum 20 which is permitted to turn in an unreeling direction by the paul 44. As the drum 20 turns, the rubber band 32 is twisted to store potential energy therein to be utilized in retrieving the ball 14. Of course, the further the ball 14

> moves away from the housing 10, the greater becomes the resistance offered to its further travel by the rubber band 32.

In column 4, lines 67-74, it is stated:

> After the ball 14 strikes the ground, it may happen that certain obstacles such as high grass, shrubbery, rocks, etc., will retard its movement faster than the rotational movement of the drum 20 is retarded by the rubber band 32. In such event the line 12 may be payed out from the drum 20 so fast that a considerable amount of slack will develop in the line between the housing 10 and the ball 14.

Further, while the Davis '312 patent discloses that the retrieving device can be used with various types of balls, it discloses that the ball is selected to practice the sport for which the ball is intended, i.e. a baseball for practicing baseball, a golf ball for practicing golf, a tennis ball for practicing tennis or a football for practicing football. It does not teach or disclose utilizing a ball of a weight and size for one sport being used to practice another sport. This is apparent from column 4, lines 34-49, which reads:

> After the cap member 38 has been adjusted to the desired position, the ball 14 is pulled away from the housing 10 until it is in the position where it will be struck by the implement to be used in practicing a certain sport. Thus, if it is desired to practice batting a baseball, the ball 14 will, of course, be a baseball and will be positioned within a theoretical strike zone between the housing 10 and the ground. On the other hand, if the ball 14 is a golf ball, enough of the line 12 will be unreeled from the drum 20 to permit the ball 14 to rest upon the ground. The ball 14 is then in a position to be struck by a driving wood or pitching iron of the golfer. It will be apparent that the other types of balls, such as tennis balls or footballs might also be attached through the line 12 to the retrieving mechanism of the present invention.

In contrast, independent Claim 1 of the present application as previously amended has nothing to do with retrieving of a ball after it has been struck and traveled a considerable distance. Rather, Claim 1 reads as follows:

> 1. A golf practice and exercise device for use with a golf club, comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club, said object having a golf clubhead impact surface of a size at least that of the corresponding surface of a softball to provide a large target so that the golfer can swing a golf club freely without concentration on striking the small target of a golf ball, said object being of a mass at least that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of a golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow-through of the golf swing.

Claim 1 is specific to an object swingably suspended from a mounting arm. Clearly, the Davis '312 patent does not teach or disclose or otherwise relate to a swingable object, but rather to a ball that is to be struck and fly a considerable distance away from the device. The Davis disclosure does not teach or suggest an object of a size at least that of a softball being utilized in a swinging arrangement so that a golfer can swing a golf club freely without concentration on striking the small target of a golf ball and with the object being of a mass at least that of a softball to provide substantial resistance to the impact of the golf club to impose muscular strain on the golfer for muscle development, but being limited in mass and being swingable so that the movement of the object when being struck will be to swing outwardly and upwardly away from the golf clubhead to a position that will allow a golf clubhead to pass underneath such the practicing golfer can complete a follow-through motion.

For the foregoing reasons, it is respectfully submitted that the Examiner was correct in not previously citing the Davis '312 patent during the three years of prosecution of the present

application, and is incorrect in now citing it. Reconsideration and allowance of the pending claims of the application are respectfully requested.

Respectfully submitted,

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